

## II. Rejections under § 103(a)

### A. *Matsunaga* in view of *Pratt*

The Examiner rejects claims 1-14, 16, 19-21, 26-43, 46, and 50-59 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2001/0054206 to Matsunaga et al. ("*Matsunaga*") in view of U.S. Patent Application Publication No. 2003/0019052 to Pratt ("*Pratt*"). Office Action, page 2. Specifically, the Examiner alleges that *Matsunaga* teaches a hair dyeing composition comprising a fluorescent dye of azomethine compound of formula (2), which is similar to the formula (F2) as recited in the rejected claims. *Id.* The Examiner admits that *Matsunaga* does not teach the at least one polyol of formula (I) as recited in the rejected claims. *Id.* at page 3. To remedy this deficiency, the Examiner alleges that because *Matsunaga* "suggests the use of polyol in the hair dyeing compositions" (citing *Matsunaga*, page 3, paragraph 0024) and *Pratt* teaches a composition comprising polyols such as 1,4-butanediol, it would have been obvious to modify *Matsunaga*'s composition by adding in *Pratt*'s polyol, such as 1,4-butanediol. *Id.* at pages 3-4. Applicants respectfully disagree and traverse this rejection for at least the following reasons.

To establish a *prima facie* case of obviousness, three basic criteria must be met, including that there is some suggestion or motivation, either in the cited reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference teachings. M.P.E.P. § 2143. The teaching or suggestion must be found in the prior art, not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Here, the Examiner has failed to point to any evidence of a suggestion or motivation to modify *Matsunaga*'s composition to arrive at the present invention as alleged by the Examiner. *Matsunaga* discloses a hair dye composition comprising an "azamethine" compound. *Matsunaga*, page 1, paragraph [007]. *Matsunaga* further teaches that its composition can also comprise a polyol, but this general teaching must be considered in context: specifically, *Matsunaga* lists polyol, polyol alkyl ether, cationic or amphoteric polymer or silicone as possible additives to improve cosmetic properties, but says nothing else about them. *Id.* at page 3, paragraph [0024]. There is no direction in this passage that would have motivated one of ordinary skill in the art to choose polyols from among the other choices of additives and include it into the composition in the first place.

Second, solely for purposes of argument, even if polyols were chosen, there is no evidence of a suggestion or motivation to choose *Pratt*'s diol and add it to *Matsunaga*'s composition as alleged by the Examiner. "Polyol" is a broad genus, encompassing a myriad of compounds. The diol disclosed in *Pratt* is merely a small subset of the polyol genus. Even if one did decide that polyols should be added to *Matsunaga*, there is still absolutely no suggestion or motivation in the cited art to choose a diol as the polyol.

Third, solely for purposes of argument again, even if *Pratt*'s diol were chosen, there is no suggestion or motivation to choose a specific diol, such as 1,4-butanediol, which falls into the scope of the rejected claims, from among other diols, such as 1,2- or 1,3-propanediol, which does not fall into the scope of the rejected claims. Specifically, *Pratt* discloses that its composition can also comprise "a C3-C6-alkanediol or the ethers

thereof, in particular a mono-C1-C3-alkyl ether.” *Pratt*, page 4, paragraph [0052]. *Pratt* further discloses that “[p]referred substances in this context are 1,2- and 1,3-propanediol . . . and 1,4-butanediol . . .” *Id.* at paragraph [0053]. Neither 1,2- nor 1,3-propanediol falls into the scope of the rejected claims, which recite, for example, in claim 1, that the at least one polyol comprises “more than three carbon atoms.” (Emphasis added). The Examiner has failed to provide any evidence of a suggestion or motivation to choose 1,4-butanediol, rather than 1,2- or 1,3-propanediol, although they are all equally disclosed in *Pratt*, and add it to *Matsunaga*’s composition. Apparently, the Examiner has adopted an improper hindsight approach, using the presently claimed invention as a blueprint.

In view of the above, this rejection is improper. Accordingly, as the Examiner has failed to establish a *prima facie* case of obviousness, Applicants respectfully request this rejection be withdrawn.

**B. *Matsunaga* in view of *Pratt* and further in view of *Miyabe***

The Examiner rejects claims 15 and 44 under 35 U.S.C. § 103(a) as being unpatentable over *Matsunaga* in view of *Pratt* and further in view of EP 1 142 559 to Miyabe et al. (“*Miyabe*”). Office Action, pages 4-5. Applicants respectfully disagree and traverse this rejection for at least the following reason.

*Miyabe* is merely relied on for its teaching of the direct dyes. *See id.* *Miyabe* does nothing to cure the deficiencies of the § 103(a) rejection over *Matsunaga* in view of *Pratt* as set forth above in subsection A. Therefore, this rejection is improper.

Accordingly, as the Examiner has failed to establish a *prima facie* case of obviousness, Applicants respectfully request this rejection be withdrawn.

**C. *Matsunaga* in view of *Pratt* and further in view of *Vandenbossche***

The Examiner rejects claims 22-24 under 35 U.S.C. § 103(a) as being unpatentable over *Matsunaga* in view of *Pratt* and further in view of U.S. Patent No. 6,391,062 to Vandenbossche et al. ("*Vandenbossche*"). Office Action, pages 5-6. Applicants respectfully disagree and traverse this rejection for at least the following reason.

*Vandenbossche* is merely relied on for its teaching of the direct dyes. *See id.* *Vandenbossche* does nothing to cure the deficiencies of the § 103(a) rejection over *Matsunaga* in view of *Pratt* as set forth above in subsection A. Therefore, this rejection is improper.

Accordingly, as the Examiner has failed to establish a *prima facie* case of obviousness, Applicants respectfully request this rejection be withdrawn.

**D. *Matsunaga* in view of *Cottard* and further in view of *Giuseppe***

The Examiner further rejects claim 25 under 35 U.S.C. § 103(a) as being unpatentable over *Matsunaga* in view of *Pratt* and further in view of U.S. Patent No. 5,744,127 to Giuseppe et al. ("*Giuseppe*"). Office Action, pages 6-7. Applicants respectfully disagree and traverse this rejection for at least the following reason.

*Giuseppe* is merely relied on for its teaching of a composition, which can be used as both a hair shampoo and a hair dyeing composition. *See id.* at page 7. *Giuseppe* does nothing to cure the deficiencies of the § 103(a) rejection over *Matsunaga* in view of *Pratt* as set forth above in subsection A. Therefore, this rejection is improper.

Accordingly, as the Examiner has failed to establish a *prima facie* case of obviousness, Applicants respectfully request this rejection be withdrawn.

**E. *Matsunaga* in view of *Pratt* and further in view of *Vandenbossche***

The Examiner also rejects claim 49 under 35 U.S.C. § 103(a) as being unpatentable over *Matsunaga* in view of *Pratt* and further in view of U.S. Patent No. 6,436,153 to Rondeau et al. ("*Rondeau*"). Office Action, pages 7-8. Applicants respectfully disagree and traverse this rejection for at least the following reason.

*Rondeau* is merely relied on for its teaching of the fluorescent compounds. See *id.* *Rondeau* does nothing to cure the deficiencies of the § 103(a) rejection over *Matsunaga* in view of *Pratt* as set forth above in subsection A. Therefore, this rejection is improper.

Accordingly, as the Examiner has failed to establish a *prima facie* case of obviousness, Applicants respectfully request this rejection be withdrawn.

**III. Allowable Subject Matter**

Applicants acknowledge, with appreciation, the indication of allowable subject matter in claims 17, 18, 45, 47, and 48, and note that such claims are objected to as based on rejected parent claims. See Office Action, page 8. Despite the indication that they would be allowed if rewritten in independent form, Applicants have decided to keep these claims in dependent form for the reasons discussed above, e.g., that the rejections of claims 1-16, 19-44, 46, and 49-59 are improper and should be withdrawn. Accordingly, Applicants respectfully request this objection be withdrawn.

#### **IV. Conclusion**

In view of the foregoing remarks, Applicants respectfully request the reconsideration of this application and the timely allowance of the pending claims.

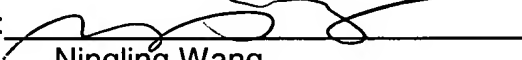
If the Examiner believes a telephone conference would be useful in resolving any outstanding issues, he is invited to call Applicants' undersigned representative at (202) 408-4218.

If there is any fee due in connection with the filing of this response, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

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By:   
Ningling Wang  
Reg. No. 52,412